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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,377	03/21/2001	Robert David Freeman	4154-11-CIP	3940

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MACPHERSON KWOK CHEN & HEIDI  
1726 TECHNOLOGY DRIVE  
SUITE 226  
SAN JOSE, CA 95110

EXAMINER

WATKO, JULIE ANNE

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 07/09/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/815,377

Applicant(s)

FREEMAN ET AL.

Examiner

Julie Anne Watko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 2-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. It is noted by the Examiner that claim 1 is no longer generic. The limitation "a second portion pivotally mounted to said first portion and configured to position said first end along an arcuate path relative to the surface of the disk" renders claim 1 non-readable on Species C, for example. See especially Figs. 16-17 and page 24, lines 17-22 of the specification, which discloses a non-arcuate path.
2. It is noted by the Examiner that claim 2, now depending from amended claim 1, is not currently readable on elected Species A, drawn to Figs. 3-12, wherein said figures do not show at least three planar elements of a second portion pivotally mounted to said first portion and configured to position said first end along an arcuate path relative to the surface of the disk. Claim 2 and all claims depending therefrom are hereby withdrawn from consideration as drawn to non-elected species.
3. Claims 2-21 remain pending, but have been withdrawn from consideration, without traverse, as drawn to non-elected species. No claim is currently generic.

### ***Drawings***

4. New corrected drawings are required in this application because the proposed drawing correction filed on June 3, 2004, has been approved by the Examiner. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

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5. Applicant has provided postcard evidence that corrected formal drawings were filed by mail on January 28, 2004, in a paper that was not matched with the file record until resubmitted by Applicant via fax, without corrected formal drawings. The Examiner apologizes, and courteously requests that Applicant resubmit the corrected formal drawings in reply to this action.

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Boutaghou et al (US Pat. No. 5521778).

As recited in claim 1, Boutaghou et al show an optical disk drive comprising: a housing 10 including a base portion 32; and an actuator assembly (see Fig. 5) having a first end (right end in Fig. 5) and configured for use with an optical disk 12 ("optical disks", see col. 4, line 31) having information on at least one side, said actuator assembly including: a first portion 24 configured to position said first end of said actuator assembly parallel to the surface of the disk 12; and a second portion 25 pivotally mounted to said first portion and configured to position said first end along an arcuate path (see 26, 26', 26'', 26''' and 26''') relative to the surface of the disk 12; and an optical pick up unit 26 disposed at said first end of said actuator assembly, said optical pick up unit (inherently) acting to focus a light beam on said optical disk.

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***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stole et al (US Pat. No. 6091578) in view of Boutaghou et al (US Pat. No. 5521778).

As recited in claim 1, Stole et al show an optical disk drive comprising: a housing including a base portion 122; and an actuator assembly 132 having a first end 18 and configured for use with an disk 18 having information on at least one side, said actuator assembly including: a first portion 134 configured to position said first end of said actuator assembly parallel to the surface of the disk; and a pick up unit 136 disposed on said first end of said actuator assembly.

As recited in claim 1, Stole et al are silent regarding the disk and pick up unit being an optical disk and an optical pick up unit, and a second portion pivotally mounted to said first

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portion and configured to position said first end along an arcuate path relative to the surface of the disk; said pick up unit acting to focus a light beam on said optical disk.

As recited in claim 1, Boutaghou et al show a disk and pick up unit being an optical disk 12 ("optical disks", see col. 4, line 31) and an optical pick up unit 26, and a second portion 25 pivotally mounted to a first portion 24 and configured to position said first end along an arcuate path relative to the surface of the disk; said pick up unit (inherently) acting to focus a light beam on said optical disk.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the actuator assembly of Stole et al in an optical drive with an optical pickup and optical disk as taught by Boutaghou et al. The rationale is as follows: one of ordinary skill in the art would have been motivated to employ the actuator assembly of Stole et al in an optical drive with an optical pickup and optical disk in order to increase a durability of data storage as is notoriously well known in the art.

It would have been further obvious to one of ordinary skill in the art at the time the invention was made to add the second portion of Boutaghou et al to the actuator assembly of Stole et al as taught by Boutaghou et al. The rationale is as follows: one of ordinary skill in the art would have been motivated to add the second portion to the actuator assembly in order to improve recording head resolution, and to reduce costs by using a coarser primary actuator as taught by Boutaghou et al (see col. 2, lines 54-63, "improve recording head resolution ... position the recording head at intermediate positions between primary head positions as defined by the actuator arm resolution"; see also col. 4, lines 40-45, "permits the use of less expensive

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coarser actuators which then may be implemented as a cost-saving technique while DASD still may attain comparable enhanced recording track densities”).

***Response to Arguments***

11. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Anne Watko whose telephone number is (703) 305-7742. The examiner can normally be reached on Monday-Thursday, 9AM-5PM, Friday 9AM-7:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Julie Anne Watko  
Primary Examiner  
Art Unit 2652

June 28, 2004  
JAW

A handwritten signature in black ink, appearing to read 'Julie Anne Watko', with a stylized, elongated flourish extending to the right.